

REMARKS

This responds to the Office Action dated October 19, 2004.

None of the claims are amended. Claims 1-33 are pending in the application.

§103 Rejection of the Claims

Claims 1-14 and 21-24 were rejected under 35 USC § 103(a) as being unpatentable over Pansini (U.S. Patent No. 2,975,791) in view of Peterson (U.S. Patent No. 4,852,337).

Claims 1-7

Applicant traverses the obviousness rejection since there is no suggestion to combine the references as suggested by the Examiner. Moreover, even if combined, the combination does not include each limitation recited in claim 1.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).

In this case, the secondary reference, Peterson, teaches away from the present claimed invention. Peterson discusses a rake to pull weeds out by their root (i.e. “The only effective method is to remove the weeds at their source, which is the roots.” Col. 1, lines 53-54). This is completely opposite of the present claimed invention which recites: a weed contacting member that “repeatedly brushes against any weeds in the bed of weeds.” In contrast, Peterson specifically states, that his device “pulls the plant 72, roots and all, out of the bottom 70.” (Col. 5, lines 14-15). This clearly teaches away from the present claimed invention which includes a weed contacting member which “brushes” against the weeds so as to disintegrate the weeds.

Moreover, Applicant traverses the combination of the two cited references. Peterson discusses a rake for removing weeds from a lake. Pansini is directed to a pool cleaner. These are two different tasks requiring differing apparatus and technique. There is no suggestion or motivation to look from one field to the other.

Another factor against the motivation to combine is that the Office Action asserts inadequate logic to support the finding of a motivation. In paragraph 3, the Office Action asserts that one skilled in the art would think of putting tines on “the device of Pansini ‘791 in order to provide an effective raking action.” Applicant traverses this assertion. The prior art nowhere states or implies that Pansini has any need of a raking action. Why does a pool cleaner need a raking action? If there are any leaves in the pool, the Pansini device with a rake attached would merely push the leaves back and forth across the bottom of the pool. This is simply not an adequate motivation to combine the references. Moreover, how would one actually modify Pansini with tines located parallel with the support member? The Examiner has not given any explanation of how such a rake could be attached to Pansini nor how Pansini’s hose would still work with a rake attached.

Moreover, Applicant believes claim 1 is not obvious in view of the cited references since, even if combined, the combination does not include each limitation recited in the claim. Applicant again traverses the characterization that Pansini moves in a “repeating circular arc pattern,” as claimed. Pansini discusses a pool cleaner where a hose operates under a random motion to clean the pool. (Col. 4, lines 56-58). This random motion is not a repeating circular arc pattern.

Claims 2-7 include each limitation of their parent claim and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 8, 9, 12, and 21

Independent claims 8, 9, 12, and 21 also include similar limitations as claim 1 and the above discussion is incorporated herein by references. Moreover, regarding claim 12, Applicant again traverses the characterization that Pansini includes a weed contacting member that “moves in a repeating pattern,” as recited in claim 12.

Dependent claims 10-11, 13-14, and 22-24 include each limitation of their respective parent claims and are therefore also not anticipated in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 25-30 were rejected under 35 USC § 103(a) as being unpatentable over Pansini (U.S. Patent No. 2,975,791) in view of Majkrzak (U.S. Patent No. 5,359,835).

Claims 25-26, and 30

Applicant traverses the rejection of claim 25 in view of the cited references since there is no motivation in the art to combine the references as suggested.

Pansini is directed to a pool cleaner. Majkrzak discusses a device for removing weeds from a lake. These are two different tasks requiring differing apparatus and techniques. There is no suggestion or motivation to look from one field to the other.

Moreover, the Office Action's asserted motivation is illogical. The Office Action states it would be obvious to use Pansini in a lake or river "as taught by Majkrzak in order to prevent interference with recreation such as swimming and boating." Applicant does not understand the Office Action's reasoning. If Pansini was in a lake it would actually provide more interference with swimming than Majkrzak since Majkrzak is under water and Pansini is over the water. Moreover, there is no reason to put Pansini in a lake. Pansini would not do anything if it was in a lake. The purpose of Pansini is to clean a swimming pool by blowing water through a hose nozzle to remove the "accumulated scum and dirt from the pool sides and bottom and dispersing the same in the water for handling by the pump filter system." (Col 1, lines 41-44). This action would be useless in a lake or river, so there is no motivation to use it in such a location.

In the Response to Arguments section of the Office Action, the Examiner states that "[i]n a claim drawn to the process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey* 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)." In this case, this principle is not directly applicable. Claim 25 is a process of use claim, not a process of making. This is distinguishable from the *In re Otto* case where the court held that the intended use of hair curling was of no significance to the process of making a core member for a hair curler. Here, the intended use of weed control is of inherent significance to the process of using a weed controller. Moreover, those cases are cases dealing with whether an intended use recited in a preamble of a claim limits the claim. Here, the body of the claim recites "repeatedly brushing a bed of weeds with a weed contacting member which is suspended and freely hanging down from a support member located proximate a surface of the

lake or river.” Thus the present method claim is clearly limited to use in a lake or river. Furthermore, it is settled law that a new use for an old structure is patentable. (See MPEP 2112.02).

Dependent claims 26 and 30 include each limitation of their parent claim and are therefore also not obvious in view of the cited reference for the reasons given above. Reconsideration and allowance is respectfully requested.

Claims 27-29

Claim 27 is a method claim including similar limitations as claim 25, and the discussion above is incorporated herein by reference.

Claim 28 and 29 include each limitation of the parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claim 31 was rejected under 35 USC § 103(a) as being unpatentable over Pansini (U.S. Patent No. 2,975,791) and Majkrzak (U.S. Patent No. 5,359,835) as applied to claim 25 above, and further in view of Lubins (U.S. Patent No. 2,122,692).

Claim 31 includes each limitation of its parent claim and is not obvious in view of the cited references for the reasons given above for claim 25. Reconsideration and allowance is respectfully requested.

Allowable Subject Matter

Applicant acknowledges the allowance of claim 15-20, 32 and 33.

RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

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Title: METHOD AND SYSTEM TO CONTROL WEEDS

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Dkt: 564.002US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17 day of December, 2004.

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